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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/628,496 07/28/00 BRESNAN

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EXAMINER

TM02/0925

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ART UNIT

PAPER NUMBER

2161

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09/25/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/628,496

Applicant(s)

BRESNAN ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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1. Applicant should note the changes to patent practice and procedure effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997.

2. In regard to the instant reissue application, the following has been noted:

A) an reissue declaration signed by the inventors Bresnan and Oh, which asserts an error has been received.

B) the consent of the assignee of US Patent no. 5,873,073 which is sought to be reissued by the instant reissue application, has been received.

C) the reissue declaration complies with 37 CFR § 1.175(a)(1) and 37 CFR § 1.175(a)(2).

D) an offer to surrender the original U.S. Patent 5,873,073 as required by 37 CFR § 1.178 has not been received on June 05, 2001.

E) the instant reissue application, which seeks to broaden the claimed invention, contains a new declaration executed by inventors Bresnan and Oh.

F) the instant reissue application, which seeks to broaden the claimed invention has been filed within two years of the issue date of US Patent no. 5,873,073.

G) new claims 20-51 as submitted do not conform to the requirements of 37 CFR § 1.121(b)(2)(ii), since the amendment was not accompanied by the required statements in support of the amended subject matter.

H) the prior art cited in the original patent, US Patent no. 5,873,073, has been cited in the Information Disclosure Statement filed July 28, 2000, and considered by the examiner.

I) in regard to the recapturing of claimed subject matter lost during the prosecution of the original patent, the original disclosure does not permit the use of a single printer to print both the contents and mailing information on the envelope. Therefore, the printers mentioned in the claims added by the instant reissue application must include the use of two separate printers. Hence, the deletion of the references to the first and second printers in the claims sought to be added by the instant reissue application is not an attempt to recapture claimed subject matter.

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3. It is noted that the amendments filed 28 July 2000 and 06 August 2001 do not conform to 37 CFR § 1.173; 37 CFR § 1.121(b)(1)(i); 37 CFR § 1.121(b)(1)(ii); 37 CFR § 1.121(b)(2)(i)(A); 37 CFR § 1.121(b)(2)(i)(C); 37 CFR § 1.121(b)(2)(iii); and 37 CFR § 1.121(b)(6), since:

A) the amendment filed 28 July 2000 does not conform to the requirements of 37 CFR § 1.173; 37 CFR § 1.121(b)(2)(i)(A); 37 CFR § 1.121(b)(2)(i)(C); 37 CFR § 1.121(b)(2)(iii); and 37 CFR § 1.121(b)(6). Note new claim 43 which has not been underlined as required.

B) the amendment filed 06 August 2001 does not conform to the requirements of 37 CFR § 1.173; 37 CFR § 1.121(b)(2)(i)(A); 37 CFR § 1.121(b)(2)(i)(C); 37 CFR § 1.121(b)(2)(iii); and 37 CFR § 1.121(b)(6). Note amended original claims 1, 3 & 18 which do not contain the brackets and underlining relative to the original claims as required and new claims 38, 43 & 48-51 which have not been underlined as required.

C) the amendment filed 06 August 2001 does not conform to the requirements of 37 CFR § 1.173; 37 CFR § 1.121(b)(1)(i); 37 CFR § 1.121(b)(1)(ii); and 37 CFR § 1.121(b)(6). Note amended paragraphs on pages 1, 2, 4, 8-15 which do not contain the brackets and underlining relative to the original patent as required.

4. The disclosure is objected to because of the following informalities:

A) the following disclosed subject matter is confusing:

(1) applicant's amendment which adds the phrase "The input to step 375 comes from C5" to the disclosure at page 8, lines 22-24, "Turning to FIG. 5D, there is shown ... where the system returns the user to the Main menu.", is confusing, since as can be seen in fig. 5D and from the context of the disclosure, this phrase should read --The input to step 376 comes from C5--, (note page 4 of the amendment filed 06 August 2001).

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings.

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Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)) & § 1.121(a)(1)-1.121(a)(6).

6. The amendment filed 06 August 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is described below.

6.1 Neither the disclosure of US Patent no. 5,873,073 nor the instant disclosure as originally filed provide support for using permit mail. It is noted that as originally disclosed the recited purpose of the invention is to produce a finished mail piece. Further, as originally disclosed a finished mail piece does not include permit mail, because original disclosure defines a finished mail piece as a mail piece that is required to be properly franked, see at least:

- A) the abstract;
- B) the summary of the invention at page 2; and
- C) page 4, lines 7-17.

Hence, applicant's addition of the phrase "if it is not permit mail" to:

A) page 2, lines 37-47, "Once the document has been printed ... and then franked if it is not permit mail with ... duplicate detection as applied to the address list.", adds disclosure and a decision function which lacks support in the original disclosure.

B) page 4, lines 4-17, "At step 118, the printed document is merged ... is franked if it is not permit mail with ... into the mail stream at step 122.", adds disclosure and a decision function which lacks support in the original disclosure.

Therefore these amendments add new matter to the disclosure.

6.2 Applicant is required to cancel the new matter in the reply to this Office action.

7. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most

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nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7.1 The specification is objected to under 35 U.S.C. § 112, first paragraph, as:

A) the specification, as originally filed, does not provide support for the invention as now claimed.

7.1.2 For the reason given above in section 6.1, the use of permit mail in claim 51 is new matter.

7.1.2 Claim 51 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

8. Claims 20, 24, 28-39 & 43-47 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8.1 Claims 20, 24, 28-39 & 44-47 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:

A) the recited purpose of the invention is to produce a finished mail piece, that is an item of mail that has been properly franked, see at least

(1) the abstract;

(2) the summary of the invention at page 2; and

(3) page 4, lines 7-17.

However, claims 20, 24, 28-39 & 44-47, fail to recited that the item of mail is franked and hence it is not a finished mail piece as the instant invention is intended to produce.

Hence, claims 20, 24, 28-39 & 44-47, fail to accomplish the desired result of the invention as set forth in the disclosure.

For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

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8.2 The scope and meaning of claim 43 can not be properly determined, since claims 43 as submitted does not conform to the requirements of 37 CFR § 1.173; 37 CFR § 1.121(b)(2)(i)(A); 37 CFR § 1.121(b)(2)(i)(C); 37 CFR § 1.121(b)(2)(iii); and 37 CFR § 1.121(b)(6), because it is a new claim that has not been completely underlined as required by 37 CFR § 1.121(b)(6).

8.4 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

9. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

9.1 Claims 1-4, 6-12, 15-36, 38-46 & 48-50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Cordery et al (5,628,249 or Harmon et al (5,684,706) or Baker et al (5,067,305) or Murcko et al (5,476,255) in view of Humes et al (5,377,120) and common practice.

9.1.1 In regard to claims 1-4, 6, 7, 11, 12, 15-22, 24-26, 29-36, 38-41, 43-46 & 58-50 either Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) disclose a computer mail processing system that creates mailing. Any one of these systems at a first computer/node creates the electronic data that describes the characteristics of one or more mail pieces, color, shape, size, postage class, include a reply envelope, etc. This electronic data

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further includes document data for each mail piece and the associated mailing list/data, i.e. destination data. The document data and mailing list are then merged into a single electronic data file, that is then sent/transmitted to a second processor/node.

9.1.2 At the second processor/node, the electronic data is parsed into envelope/postage data and document data, which is then sent to a mail production machine. The envelope data is used by a first printer to print address data and postage indicia on an envelope. While, the document data is used by a second printer to generate the document. The item mail is completed when the printed document is stuffed/inserted into the associated preprinted envelope and the envelope is sealed. The sealed envelope is then franked so as to produce a finished item of mail and placed in the mail stream for delivery to the destination printed on the item of mail.

9.1.3 Neither Baker et al ('305) nor Murcko et al ('255) nor Cordery et al ('249) nor Harmon et al ('706) disclose that the second processor/node is necessarily separate and not under the control of the first processor/node. However, Humes et al ('120) in the environment of mail processing discloses the following mail processing system. A third party, other the source of the mailing data/items, uses a computer system which is not co-located with the computer that is the source of the mailing data/items or under the control of the computer that is the source of the mailing data/items to collect mailing data that defines item of mail from a number of different mailers/sources. The collected mail data is then used to produce a finished item of mail in accordance with the mailing data, i.e. mail characteristics, mail document data and destination data, as sent from the source of the mail data/items. The production of a finished item by the third/independent party may include the third/independent party combining/merging documents from a number of mail sources into a single item of mail based on one or more mailing lists from the sources of the mailing data/item. The independent third party would then produce a merged mailing by printing the combined document data based on the mailing lists to create a finished item of mail that will be placed into mail stream of the postal system. It is noted that the documents and mailing lists are merged by the third party so as to remove incorrect and/or duplicate mailing address and to combine mailing documents to the same destination in such a manner so as to provide an overall lower mailing cost to each of



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the sources of mailing data/items. Since the system of Humes et al ('120) provides the benefit of lower mailing costs to a mailer, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) could be modified to use separately located mail production facility that is not co-located or under the control of the computer system that produced the mail data/items as the second processor/node to provide the functions of removing incorrect and duplicate mailing address and producing the finished mail item as taught by Humes et al ('120).

9.1.4 Further in regard to claims 1, 21, 22, 25, 26, 40 & 41, it is noted that neither Baker et al ('305) nor Murcko et al ('255) nor Cordery et al ('249) nor Harmon et al ('706) actually depict a postage meter. However, each of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) disclose that after the completed mail piece has been generated, the mail piece is franked and placed in the postal system for delivery. Since, the function of franking an item of mail commonly requires a postage meter or a system that provides the equivalent function/system of a postage meter, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) include a postage meter to produce a finished mail piece.

9.1.5 In regard to claims 8-10, since the systems of either of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) as modified by Humes et al ('120) and interpreted in view of common practice, transmit the mailing data/file from one node to the next with out restricting the communications path/link, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) ) as modified by Humes et al ('120) and interpreted in view of common practice could include any number of nodes absent applicant's indication of unexpected results from a particular number of nodes.

9.1.6 In regard to claims 23, 27 & 43, since the systems of either of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) as modified by Humes et al ('120) and interpreted in view of common practice, require the determination of the

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appropriate amount of postage for an item of mail and the size, shape, weight affect the require postage, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) ) as modified by Humes et al ('120) and interpreted in view of common practice would consider the characteristics of the item of mail when determining the require postage.

9.1.7 In regard to claim 28, since the systems of either of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) as modified by Humes et al ('120) and interpreted in view of common practice, transmit the mailing data/file from one node to the next with out restricting exactly or how the print file is formed and transmitted, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Baker et al ('305) or Murcko et al ('255) or Cordery et al ('249) or Harmon et al ('706) ) as modified by Humes et al ('120) and interpreted in view of common practice could generate the print filed as a combined file of the mailing list file and document file or a file of individual complete items of mail absent applicant's indication of unexpected results from a particular method of transmitting the print file.

9.2 Claims 5, 37 & 47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Cordery et al (5,628,249 or Harmon et al (5,684,706) or Baker et al (5,067,305) or Murcko et al (5,476,255) as modified by Humes et al (5,377,120) and in view of common practice as applied to claims 1, 20 & 38, and further in view of common business practice.

9.2.1 In regard to the receipt of claims 5, 37 & 47, the systems of either Cordery et al ('249 or Harmon et al ('706) or Baker et al ('305) or Murcko et al ('255) as modified by Humes et al ('120) and in view of common practice require the mailing data to be sent and processed by a third party. Further, it is common business practice by a service provider to be required to provide a receipt as proof that a service has been provided before the service provider is paid for that service. Hence, it would have been obvious to one of ordinary skill at the time the invention was made that the operator of any one of the systems of either Cordery et al ('249 or Harmon et al ('706) or Baker et al ('305) or Murcko et al ('255) as modified by Humes et al

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('120) and in view of common practice, would require the third party to provide a receipt as is common business practice.

9.3 Claims 13 & 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Harmon et al (5,684,706) as modified by Humes et al (5,377,120) and in view of common practice as applied to claims 1, 11 & 12.

9.3.1 In regard to claims 13 & 14, Harmon et al ('706) further discloses that a second central computer system checks to see if the supplies required to generate the mail piece(s) are available at anyone of a number of mail piece generating stations. And schedules the task of generating the mail piece at the appropriate mail piece generating station.

10. Response to applicant's arguments.

10.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

10.2 As per the 35 U.S.C. § 103 rejection, since:

A) one of ordinary skill at the time the invention was made would have realized that once the mailing data/list is sent to the third party in the systems of either Cordery et al (5,628,249 or Harmon et al (5,684,706) or Baker et al (5,067,305) or Murcko et al (5,476,255) in view of Humes et al (5,377,120) only the computer system/network of the third party may control the production of the items of mail, applicant's argument's are non persuasive.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)-305-9768. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

12.1 The fax phone number for UNOFFICIAL FAXES or for OFFICIAL FAXES for this group is either (703) 308-6165 or (703) 308-6296 or (703) 308-6306 or (703) 308-6606 or (703) 308-9051 or (703) 308-9052.

09/19/01



Edward R. Cosimano  
Primary Examiner A.U. 2161